



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,194	04/20/2001	Jeremy P. Clifford	05793.3026-00	1551

22852 7590 07/09/2008
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

GREIMEL, JOCELYN

ART UNIT	PAPER NUMBER
----------	--------------

3693

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

07/09/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Office Action Summary	Application No. 09/838,194	Applicant(s) CLIFFORD ET AL.	
	Examiner JOCELYN GREIMEL	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is in response to Applicant's Amendments and Remarks filed 12 March 2008.

Status of Claims

Claims 1-30 are currently pending. Claims 1, 6, 11 and 26 are currently amended.

Claim Objections

The claim objection to claim 26 is withdrawn.

Response to Arguments

Applicant's arguments filed 12 March 2008 have been fully considered but they are not persuasive. The 35 U.S.C. 102(b) rejections under Walker et al are maintained as detailed below.

1. Issue no. (1): Applicants argue on page 13 of the Arguments that Walker et al (hereinafter, Walker) reference teaches: "If the customer decides that the account price is not acceptable during step 15, the customer is given a chance to revise the initially

selected credit card parameters in step 18." Applicants argue that in Walker, the customer is not requested to further define the originally selected credit card parameters (as in the proposed invention) and instead, the customer changes the initially selected parameters to entirely different parameters.

2. Response: The Examiner is entitled to give the claim limitations their broadest reasonable interpretation in light of the Specification (see below):

Claim Interpretation; Broadest Reasonable Interpretation:

<CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541, 550-51 (CCPA 1969).>

The Walker reference does disclose the customer further defining the originally selected credit card parameters (Walker, at least col. 8). Walker teaches "the customer is given the chance to revise the initially selected credit card parameters". Conclusion: Under their broadest reasonable interpretation in light of the Specification, the claims are taught and no inventive concept is found.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al. (US Patent No. 5,970,478). In reference to claims 1, 6, 11, 22, 25 and 28, Walker discloses a method, system and computer readable medium for customizing a financial account product for an applicant comprising: receiving account preference information from the applicant, the account preference information describing the applicant's preferences concerning various features of the financial account product; recommending at least one first financial account product to the applicant based on the received account preference information; providing to the applicant a plurality of selectable options and/or an unselectable options for further defining predetermined features of the recommended financial account product; receiving the applicant's selected options for further defining the predetermined features of the recommended financial account product; and customizing the recommended financial account product based on the applicant's selected options (col. 2, line 56; col. 3, line 45 – col. 4, line 49; col. 5, line 39 – col. 6, line 55; col. 8, line 22 – col. 9, line 1+).

2. In reference to claims 2, 7 and 12, Walker discloses a method, system and computer-readable medium, wherein the predetermined features of the recommended

financial account product selectable by the applicant comprise: at least one of the following: an annual percentage rate associated with the financial account product, a fee structure associated with the financial account product, and a credit limit associated with the financial account product (col. 5, line 39+).

3. In reference to claims 3, 8 and 13, Walker discloses a method, system and computer-readable medium, wherein providing to the applicant a plurality of selectable options, includes: permitting the applicant to prioritize each of the plurality of predetermined features; and customizing the recommended financial account product based on the applicant's prioritization of the predetermined features (col. 5 – col. 6).

4. In reference to claims 4, 9 and 14, Walker discloses a method, system and computer-readable medium, wherein providing to the applicant a plurality of selectable options includes: determining, for a first predetermined feature, the value of the selectable option for the first predetermined feature based on an option selected by the applicant for a second predetermined feature of the recommended financial account product (col. 5 - col. 8).

5. In reference to claims 5, 10 and 15, Walker discloses a method, wherein recommending the first financial account product includes: recommending the first financial account product to the applicant based on the received account preference

information and based on information contained in an application submitted by the applicant (col. 5, line 39+).

6. In reference to claims 16-21, Walker discloses a method, system and computer readable medium for customizing a financial account product for an applicant comprising:

a. wherein the received account preference information from the applicant includes at least one of the following: information reflecting how often the applicant carries a balance for other types of financial account products, information regarding typical uses of current financial account products held by the applicant, and information reflecting one or more desired financial product features that most appeal to the applicant;

b. wherein the information regarding the one or more desired features that most appeal to the applicant includes at least one of the following: online shopping, warranty protection, replacement of less lost, stolen or damaged items, travel assistance services, ability to select a look of a new card associated with the financial account product, a payment due date, and additional authorized users associated with the financial account product (col. 5, line 39 – col. 6, line 55; col. 8, line 22 – col. 9, line 1+).

7. In reference to claims 23-24, 26-27 and 29-30, Walker discloses a method, system and computer readable medium for customizing a financial account product for an applicant comprising:

- c. wherein the at least one unselectable option includes an option for the applicant to provide a value;
- d. wherein the value corresponds to at least one of the predetermined features (col. 5, line 39 – col. 6, line 55; col. 8, line 22 – col. 9, line 1+).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOCELYN GREIMEL whose telephone number is (571)272-3734. The examiner can normally be reached on Monday - Friday 8:30 AM - 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jocelyn Greimel
Examiner, Art Unit 3693
July 6, 2008

/Stefanos Karmis/
Primary Examiner, Art Unit 3693